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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,431	12/08/2003	James J. Miller	Miller-001:CIP	2329

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THE MATTHEWS FIRM  
2000 BERING DRIVE  
SUITE 700  
HOUSTON, TX 77057

EXAMINER
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ROWAN, KURT C

ART UNIT	PAPER NUMBER
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3643

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/730,431

Applicant(s)

MILLER ET AL

Examiner

Kurt Rowan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 November 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 17-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "similar" in line 4 is indefinite since the scope of the claim is not possible to determine. See *Ex parte Kristensen*, 10 USPQ 2d 1701.

3. Claim 20 recites the limitation "the other side of the curved end" in line 11. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-15, 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Danielson in view of Schaefer.

The patent to Danielson shows a trap fishing hook. In reference to claims 1, 15, 17 and 20, Danielson shows a first shank and a second shank 2, with a tensioner 9 disposed between the first and second shanks made from a single piece of wire. Danielson shows a catch 6 integral to the first shank. Danielson shows the first and second shanks having first and second states such as in Fig. 1 for the first state where the

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shanks are parallel and a second state such where the first and second shanks cross one before the hook is released as discussed below in reference to claim 15. Danielson shows in the first state the first and second shank depend downwardly from the tensioner as shown in Fig. 3. The patent to Schaefer shows a trap fishing hook having first and second shanks 1, 1 having distal ends. Schaefer shows a tensioner 7 connected to the first and second shanks. Schaefer shows a catch 6 integral to the first shank comprising an offset disposed about the first shank at about the middle of the shank and releasable in communication with the second shank. The first and second shank having a first state and a second state. Schaefer shows that upon the application of two generally opposing forces, the first and second shanks are released to hook the fish. Schaefer shows the two opposing forces being independent of any pulling force exerted on the fish hook apparatus as discussed in column 1, lines 65-68. Hence it would have been obvious to provide Danielson with a release as shown by Schaefer since merely one mechanically equivalent release is being substituted for another and the function is the same noting that no unexpected results are shown. Danielson shows the distal end of the first shank partially obscured by the second shank as shown in Fig. 1. Further, in reference to claim 17, Danielson shows upon the application of two generally opposing forces such as a fish biting the lure from the top and the bottom and consequently the hook, that the hook will be pulled forward by the force on the line as a fisherperson feels the bite which will release the hooks from the lure as shown in Fig. 2. In reference to claim 2, Danielson shows the in the first state that the distal ends of the first and second shanks are positioned in opposite directions as shown in Fig. 2. In

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reference to claims 3-6 and 18-19, Danielson shows first and second shanks having hooks 10 with barbs the distal ends. In reference to claims 7-9, Danielson shows the tensioner 9 being a coil spring that comprises one or more coils of wire. In reference to claim 11, Danielson shows an eyelet 9 disposed about and intermediate the first and second shanks. In reference to claim 15, Danielson shows the fish hook having three states, the first state having the first and second shanks in parallel planes as shown in Fig. 2, the third state with the first and second shanks crossed twice ( such as the cross right behind the coil spring and the cross at the rear near the hooks at pin 7) as shown in Fig. 1, and the second state with the shanks crossed once which occurs when the hook is released and is moving to the first state that a point will be reached when the shanks cross only once.

In reference to claim 10, Danielson does not show a prong along the each of the first and second shanks, but it would have been obvious to employ old and well known prongs to the first and second shanks to further hook the fish. The examiner takes Official Notice that prongs along the shanks are old and well known in the art. In reference to claims 12, 13, 14, Danielson does not disclose what the fish hook is made from, but it would have been obvious to make it from a metal such as steel or a composite since the selection of a known material is based on its suitability for the intended use. See *In re Leshin*, 125 USPQ 416. Danielson shows the third state with the hooks in the set position, but it would have been obvious to employ a two shank crossing in the release position, if desired, since the function is the same and no stated problem is solved.

***Response to Arguments***

3. Applicant's arguments with respect to claims 1-15, 17-20 have been considered but are moot in view of the new ground(s) of rejection. Applicant's arguments have been generally addressed in the above rejection. However, it should be pointed out that the catches 6 of Danielson are integral to the single piece of wire. This does not preclude another catch 7 for being employed since the open-ended term "comprising" is employed. The examiner also feels that Danielson employs what has been referred to as an automatic set since any set can be automatic in that it is done by a user without thinking, but the set of Schaefer is clearly automatic since the fish does the set noting Schaefer, column 1, lines 65-68 as referred to above. As to the shanks of Danielson being crossed being crossed twice in the cocked position as shown in Fig. 1, it should be pointed out that the shanks 2, 2 are crossed once and the curved part of the hook 10, 10 are also crossed once. The combination of Danielson as modified by Schaefer requires no pulling by an angler to set the hook since the fish sets the hooks by exerting lateral forces on the fish hook apparatus and no pulling of the fishing line by either the fish or the angler is required. Regarding claim 15 and the number of times the shanks are crossed, Applicant shows several embodiments such as Figs. 6-7C where the hook shanks are crossed between zero and two times depending on the configuration and the status of the apparatus such as a cocked state of released state. Hence the number of times the shanks are crossed is deemed a matter of design choice since the function is the same and no showing of criticality has been made (no unexpected results).

***Conclusion***

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Rowan whose telephone number is 703 308-2321. The examiner can normally be reached on Monday-Thursday 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon can be reached on 703 308-2574. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Kurt Rowan", with a stylized flourish at the end.

Kurt Rowan  
Primary Examiner  
Art Unit 3643

KR